

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. Claims 1-7, 24-28, 44-47 and 59-64 were pending at the time of the outstanding Office Action. All pending claims stand rejected. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action.

Applicants incorporate their Remarks of the Amendment of January 5, 2010 by reference here.

Rejections under 35 U.S.C. § 101

Claims 24-28 stand rejected under § 101 as being directed to non-statutory subject matter. While Applicants respectfully disagree, claim 24 has been amended solely in order to facilitate expeditious prosecution to clarify that it is directed to any statutory computer readable medium.

Rejections under 35 U.S.C. § 112

Claims 1-7 and 24-38 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description of the invention requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Applicants respectfully disagree and request reconsideration and withdrawal of these rejections.

Applicants respectfully submit that the Examiner is not applying the required standard dictated by § 112. There is no *in haec verba* requirement to comply with § 112. Moreover, there is certainly no requirement that there be a finding of the claim language positively recited in the originally filed specification. See MPEP 2163. Rather, “[t]he fundamental factual inquiry is whether the specification conveys with *reasonable clarity* to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” *Id* (emphasis added).

Applicants respectfully submit that one of ordinary skill in the art would immediately recognize that the import of paragraph 0041 is that the users cannot exchange the secret code within the communications environment. If confusion on this point persists, the Examiner is invited to contact the undersigned at the telephone number listed below.

Claims 1-4 and 24-28 stand rejected under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Here, the Examiner asserts that the claim language “..the unique code is not transmissible between the first user and the second user via the multi-user communication environment” is a “negative limitation” that renders the claim indefinite. *Office Action*, p. 4. Applicants respectfully disagree.

Again, Applicants respectfully submit that the Examiner is not properly applying the law. “The current view of the courts is that *there is nothing inherently ambiguous or uncertain about a negative limitation*. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, *the claim complies with the requirements*

of 35 U.S.C. 112, second paragraph.” MPEP 2173.05(i) (emphasis added). Thus, Applicants should not be precluded from claiming the invention in this way.

As a final note, Applicants encourage the Examiner to review MPEP 2173.05(i). *Inter alia*, it contains the following: “Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support”, which may be of use to the Examiner in re-evaluating the § 112, first paragraph, rejection above.

In view of the foregoing, Applicants respectfully submit that the claim language is fully compliant with § 112 and request reconsideration and withdrawal of these rejections.

Rejections under 35 U.S.C. § 103

Claims 1-7, 24-28, 44-47 and 59-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Danieli et al. (U.S. Patent No. 7,240,093, hereinafter “Danieli”) in view of Yamada et al. (U.S. Patent Pub. No. 2002/0049805, hereinafter “Yamada”) in view of Maehiro (U.S. Patent Pub. No. 2002/0062348, hereinafter “Maehiro”) and Harvey et al. (U.S. Patent Pub. No. 2002/0059379, hereinafter “Harvey”). Either claim 63 or claim 64 stands rejected under § 103(a) as being unpatentable over Danieli, Yamada, Maehiro, Harvey, and further in view of Goldberg et al. (U.S. Patent No. 6,161,082, hereinafter “Goldberg”). Applicants respectfully disagree and request reconsideration and withdrawal of these rejections.

With the exception of claim 63 (Applicants assume the Examiner intended to reject claim 63 using Goldberg), the Examiner appears to have made the same rejection as in the prior Office Action, with the addition of Yamada. The deficiencies of the previous rejection are repeated, and Applicants respectfully restate their disagreement with them by incorporating by reference the Remarks of the Amendment of January 5, 2010 here. With regard to Yamada, Applicants respectfully submit the following.

Applicants respectfully submit that the Examiner is not properly construing the claims and moreover that Yamada does not teach what the Examiner cites it for. As the Examiner is no doubt aware, “[a]lthough the PTO emphasizes that it [is] required to give all claims their broadest reasonable construction...[The Federal Circuit] has instructed that any such construction be consistent with the specification, and that the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Suitco Surface, Inc.*, p. 8 (Fed. Cir. April 14, 2010) (available at <http://www.cafc.uscourts.gov/images/stories/opinions-orders/09-1418.pdf>) (internal quotations and citations omitted) (emphasis in original). “The broadest-construction rubric coupled with the term “comprising” does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.” *Id.*

In this regard, Applicants respectfully submit that Yamada clearly does not teach what the Examiner cites it for and does not read on the claims, as properly construed. One representative example of this is as follows. The Examiner asserts that Yamada “teaches

a method of establishing a communication between users with a menu-driven system of pre-prepared chat messages...” *Office Action*, pp. 5-6. Applicants respectfully submit that this is incorrect, as Yamada teaches a chat between a user and an agent, which is not the same as chats between two users. Moreover (and perhaps because of this difference), Yamada fails to teach “a menu-driven system of pre-prepared chat messages”, as per claim 1, because there is no reason to have a such a menu because there are no users chatting with one another in the portions cited by the Examiner.

Applicants also point out that it appears the Examiner is incorrectly rejecting the previous claim language, not that which was presented in the last amendment. That is to say, the Examiner’s rejection is deficient *ab initio* in that it does not address the actual claim language. Applicants respectfully request that the Examiner address the claim language Applicants’ actually have chosen.

In this regard, Applicants also point out that it appears the Examiner misunderstands the import of claim 59, as it cannot be lumped into a blanket rejection with claim 1 without some explanation or reasoning as to why the different claim language should be treated the same. Applicants respectfully request that claims 59-61 be specifically addressed.

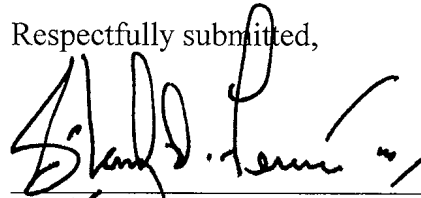
With respect to claim 63, Goldberg clearly teaches text translation, not pre-prepared chat menus in differing languages being associated via identifiers, as claimed.

Applicants respectfully reserve the right add to or expand upon the arguments presented above on appeal, as the deficiencies in the Office Action noted above are merely representative.

Conclusion

In view of the foregoing, it is respectfully submitted that claims are in condition for allowance. Notice to the effect is hereby earnestly solicited. **If the claims are not in condition for immediate allowance, the Applicants respectfully request the courtesy of a telephone interview prior to the issuance of any further Action.**

Respectfully submitted,



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